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13 Attorneys for Defendants/Counterclaim-Plaintiffs
DAKO NORTH AMERICA, INC. and DAKO
14 DENMARK A/S

15 [Additional Counsel appear on signature page]

16 UNITED STATES DISTRICT COURT
17 NORTHERN DISTRICT OF CALIFORNIA
18 SAN FRANCISCO DIVISION

19 THE REGENTS OF THE UNIVERSITY
OF CALIFORNIA, ABBOTT
20 MOLECULAR INC., and ABBOTT
LABORATORIES INC.,

21 Plaintiffs,

22 v.

23 DAKO NORTH AMERICA, INC. and
24 DAKO DENMARK A/S,

25 Defendants.

26 AND RELATED COUNTERCLAIMS.
27

Case No. C 05-03955 MHP

STIPULATION AND ~~PROPOSED~~ ORDER
RE SUPPLEMENTAL CLAIM
CONSTRUCTION

The Honorable Marilyn Hall Patel

1 WHEREAS, hearing on the parties' supplemental claim construction briefing on the
 2 proper construction of "blocking nucleic acid" is currently scheduled for April 23, 2009;

3 WHEREAS, the parties have since met and conferred and agree to a construction of
 4 "blocking nucleic acid";

5 Plaintiffs The Regents of the University of California, Abbott Molecular Inc. and Abbott
 6 Laboratories Inc. ("plaintiffs") and defendants Dako North America, Inc. and Dako Denmark A/S
 7 ("Dako") hereby stipulate as follows:

8 1) The parties agree that "blocking nucleic acid" should be construed to mean
 9 "nucleic acid used to prevent hybridization of repetitive sequences in the labeled nucleic acid to
 10 the chromosomal DNA";

11 2) The hearing on the parties' supplemental claim construction briefing scheduled for
 12 April 23, 2009 is made moot by this construction and is therefore taken off-calendar;

13 3) The hearing on Dako's Motion for Partial Summary Judgment of Noninfringement
 14 (Docket No. 269) scheduled for April 23, 2009 is made moot by this construction and is therefore
 15 taken off-calendar;

16 4) The hearing on Plaintiffs' Motion for Summary Judgment of Infringement (Docket
 17 No. 265) and Dako's Motion in Limine to Exclude Testimony of Mark E. Nusbaum (Docket No.
 18 276) also scheduled for April 23, 2009 will proceed;

19 5) Dako will have until April 17, 2009 to amend the Expert Report of Robert H.
 20 Singer, Ph.D. ("Singer Report") to address the amended construction of "blocking nucleic acid."
 21 Any amendment to the Singer Report will be limited to Dr. Singer's opinions regarding written
 22 description and enablement under 35 U.S.C. § 112 ¶ 1 that arise solely because of the amendment
 23 to the construction of "blocking nucleic acid." Specifically, any amendment will be limited to
 24 addressing any written description or enablement argument that arises from the difference in the
 25 scope of an invention that covers use of "repetitive-sequence-enriched DNA or RNA" and an
 26 invention that covers use of "nucleic acid used to prevent hybridization of repetitive sequences in
 27 the labeled nucleic acid to the chromosomal DNA." No other amendment to the Singer Report is
 28 allowed by this stipulation;

1 6) The parties agree that the opinions in the Expert Report of Dr. James Coull (“Coull
2 Report”) that the use of PNA in the accused *HER2* and *TOP2A* is not equivalent to the use of
3 “blocking nucleic acid” as claimed in the ’841 patent shall apply as well to the use of PNA in
4 Dako’s other accused products;

5 7) Plaintiffs will have until May 1, 2009 to amend the Rebuttal Expert Report of Dr.
6 Mary E. Harper (“Harper Rebuttal Report”) to respond to any amendments to the Singer Report;

7 8) Dako will make Dr. Singer available to plaintiffs for deposition to address any
8 amendment to the Singer Report. Plaintiffs will make Dr. Harper available for a supplemental
9 deposition if plaintiffs re-depose Dr. Singer;

10 9) Any amendment to the parties’ expert reports will have no effect on motions for
11 summary judgment. Specifically, any amendment to the Singer Report or the Harper Rebuttal
12 Report will not be used to supplement any of the parties’ pending motions for summary
13 judgment. Nor will any amendment to the Singer Report or the Harper Rebuttal Report be used
14 as a basis to bring any new motion for summary judgment;

15 10) Neither party will contend that this stipulation or any action taken pursuant to it
16 supports any change to the existing pretrial or trial schedule other than as provided herein.

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1 Dated: April 9, 2009

FENWICK & WEST LLP

2 By: /s/ Carolyn Chang
3 Carolyn Chang

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Attorneys for Plaintiffs/Counterclaim-Defendants
THE REGENTS OF THE UNIVERSITY OF
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and ABBOTT LABORATORIES INC.

1 Dated: April 9, 2009

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18 DENMARK A/S

ORDER

Pursuant to the foregoing Stipulation, and good cause appearing, the Court hereby orders as follows:

1) The parties agree that “blocking nucleic acid” should be construed to mean “nucleic acid used to prevent hybridization of repetitive sequences in the labeled nucleic acid to the chromosomal DNA”;

2) The hearing on the parties' supplemental claim construction briefing scheduled for April 23, 2009 is made moot by this construction and is therefore taken off-calendar;

3) The hearing on Dako's Motion for Partial Summary Judgment of Noninfringement (Docket No. 269) scheduled for April 23, 2009 is made moot by this construction and is therefore taken off-calendar;

4) The hearing on Plaintiffs' Motion for Summary Judgment of Infringement (Docket No. 265) and Dako's Motion in Limine to Exclude Testimony of Mark E. Nusbaum (Docket No. 276) also scheduled for April 23, 2009 will proceed;

5) Dako will have until April 17, 2009 to amend the Expert Report of Robert H. Singer, Ph.D. (“Singer Report”) to address the amended construction of “blocking nucleic acid.” Any amendment to the Singer Report will be limited to Dr. Singer’s opinions regarding written description and enablement under 35 U.S.C. § 112 ¶ 1 that arise solely because of the amendment to the construction of “blocking nucleic acid.” Specifically, any amendment will be limited to addressing any written description or enablement argument that arises from the difference in the scope of an invention that covers use of “repetitive-sequence-enriched DNA or RNA” and an invention that covers use of “nucleic acid used to prevent hybridization of repetitive sequences in the labeled nucleic acid to the chromosomal DNA.” No other amendment to the Singer Report is allowed by this stipulation;

6) The parties agree that the opinions in the Expert Report of Dr. James Coull (“Coull Report”) that the use of PNA in the accused *HER2* and *TOP2A* is not equivalent to the use of “blocking nucleic acid” as claimed in the ’841 patent shall apply as well to the use of PNA in Dako’s other accused products;

1 7) Plaintiffs will have until May 1, 2009 to amend the Rebuttal Expert Report of Dr.
2 Mary E. Harper ("Harper Rebuttal Report") to respond to any amendments to the Singer Report;

3 8) Dako will make Dr. Singer available to plaintiffs for deposition to address any
4 amendment to the Singer Report. Plaintiffs will make Dr. Harper available for a supplemental
5 deposition if plaintiffs re-depose Dr. Singer;

6 9) Any amendment to the parties' expert reports will have no effect on motions for
7 summary judgment. Specifically, any amendment to the Singer Report or the Harper Rebuttal
8 Report will not be used to supplement any of the parties' pending motions for summary
9 judgment. Nor will any amendment to the Singer Report or the Harper Rebuttal Report be used
10 as a basis to bring any new motion for summary judgment;

11 10) Except as provided in this order, the pretrial and trial schedule previously
12 established remains in effect.

13 **IT IS SO ORDERED.**

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15 Dated: 4/13, 2009

